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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,429	02/07/2002	Jacques Fagot	1759.071	2615

7590 12/30/2008
Rodger W Parkhurst
STEPTOE & Johnson LLP
1330 Connecticut Avenue N.W.
Washington, DC 20036

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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12/30/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACQUES FAGOT

Appeal 2007-2403
Application 10/072,429
Technology Center 3700

Decided: December 29, 2008

Before WILLIAM F. PATE III, MURRIEL E. CRAWFORD, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

WILLIAM F. PATE III, *Administrative Patent Judge*.

ON REQUEST FOR RECONSIDERATION

In our decision of April 25, 2008 we entered a new rejection of claim 11 on the ground of indefiniteness under §112, second paragraph. Appellant's arguments in the Request convince us that we overlooked the fact that Appellant had narrowly defined the expression "the volume of all the recesses" to mean -the total volume of the recesses-. In view of this definition in the Specification, we withdraw the rejection of claim

11 under §112, second paragraph, made pursuant to our authority under 37 C.F.R. § 41.50(b).

On page 3 of the request, Appellant asks for rehearing of our decision that the subject matter of claims 1, 7, 8, 12, 15, and 16 were obvious over various combinations of Peters in view of Besnard, JP7-213656 and Fenton. Appellant's argument misconstrues the jurisprudence with respect to obviousness. As we noted in our decision, Peters provides recognition in the art that the center of gravity of the club head should vary upwardly from one iron to another in a set. (Decision 3:25-4:2). Peters provides the teaching having to do with sets. Besnard teaches how to vary the center of gravity by removing mass, i.e., providing a recess in the upper portion of the peripheral edge or upper wall. (Decision 4:10, 11). While we acknowledge that no single reference, taken alone, discloses all of "a set of golf club irons, each iron of said set having a head ... wherein a volume of said at least one recess inside said upper wall varies from one iron to another within said set" (a single reference containing this disclosure would make out an anticipation) we do insist that each and every element in the claimed subject matter is disclosed in the prior art. As we cogently summed up in our decision, "Peters discloses what to do, i.e., move the center of gravity upwardly as the iron number increases. Besnard discloses how to do it, by removing material or providing recesses in the upper wall that surrounds the cavity on the back of the iron." (Decision 6:27-7:4).

To argue that these claim elements are nowhere disclosed in the prior art is simply erroneous. And contrary to Appellant's argument on page 4, there is no difference between Appellant's claimed subject matter and the applied prior art taken collectively. We cautioned Appellant in our decision from an individual attack on the references when the rejection is based on a combination of references. (Decision 7:7-8). Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Thus, we reject Appellant's argument on the bottom of page 4 that is premised on Appellant's erroneous claim that the prior art is lacking elements of Appellant's claimed subject matter. We emphatically state that this is not the case.

We acknowledge the case law provided by Appellant on page 5 of the decision. We further acknowledge that the obviousness analysis requires consideration of the claims as a whole. This is exactly the analysis the claims were given in this instance. All claim limitations were considered, and Appellant utterly fails to point out a specific element or limitation not found in the prior art. Once again, on page 6, Appellant makes the claim that there is no suggestion for varying the volume of a recess in an upper wall from one club to another within the set. Here again, we reiterate that Peters when considered with Besnard provides just such a teaching.

Appellant argues about the specific disclosure of Besnard on page 7. Appellant makes the claim that Besnard does not disclose increasing mass in the upper wall. Besnard states: “The gain in mass due to the provision of the variable volume elongated recess 3....” This portion of the Besnard disclosure clearly contemplates increasing and decreasing the mass in the upper wall to raise and lower the center of gravity of the face of the club head.

Besnard further teaches varying the number of recesses. Figures 3-7 show a single recess. Claim 16 teaches 2 or more recesses. Figures 9 and 10 teach 3 recesses. Figures 11 and 12 and the parts of Besnard pertaining thereto teach varying the depth or profile of the recesses and presumably the volume thereof. Since the number of recesses is variable and the depth or profile of the individual recesses is variable, we concluded that Besnard would have suggested changing the number of recesses, changing the depth or profile of the recesses or doing both concurrently. This is merely taking into account the inferences and creative steps that a person of ordinary skill in the art would employ. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). By our count this makes three techniques taught by Besnard for adjusting the center of gravity of the club head. Three techniques certainly qualify as a finite number, and we are of the view that under the holding of *KSR*, one of ordinary skill would find it obvious to try these three predictable variations.¹ Indeed, varying the size and number of recesses

¹ Notwithstanding that Besnard discloses changing the center of gravity of a club by providing a recess in the upper peripheral wall, the technique of varying the amount of material in a region of a part for the purpose of lightening the part, changing the balance of the part, redistributing mass in

given the explicit disclosure of Besnard is not seen as uniquely challenging or difficult for one of ordinary skill. *See Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). While we note that Appellant argues that ways to redistribute club head material are legion, they are not legion within the context of the teachings and suggestion of Besnard where varying the number and depth or profile of the recesses is specifically taught.

With respect to claim 11, since Appellant has convinced us that the claim is not indefinite within the purview of §112, we affirm the rejection of the claim under § 103 as obvious over Peters in view of Besnard. Here again, Peters teaches varying the centers of gravity of a set of irons and Besnard discloses a technique for varying the center of gravity in a cavity iron. As discussed above, changing the volume of the recesses is obvious from the disclosure of Besnard.

Conclusion

Appellant's arguments have convinced us that the rejection of claim 11 under §112, second paragraph, should be withdrawn. We hereby withdraw this rejection. As to the reconsideration requested for the obviousness

the part, changing the center of gravity of the part, or varying one of the various moments of inertia of the part is a technique well known and long practiced in the mechanical arts. Such removal is clearly within the ordinary skill in the art and yields entirely predictable results. *See, for example, DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1369 (Fed. Cir. 2006) (Indeed, we have repeatedly held that an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the "improvement" is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, *lighter*, smaller, more durable, or more efficient.).

Appeal 2007-2403
Application 10/072,429

rejections, we have granted this request to the extent that we have reconsidered our previous affirmance of the rejections, but we deny the request with respect to making any changes thereto. Additionally, the obviousness rejection of claim 11 is affirmed.

This is a final agency decision for purposes of judicial review.

RECONSIDERATION-GRANTED-IN-PART

PL: vsh

RODGER W PARKHURST
STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE N.W.
WASHINGTON DC 20036